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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,064	11/13/2001	Yoshiyuki Kawano	204552018610	6348

25227 7590 06/04/2003  
MORRISON & FOERSTER LLP  
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EXAMINER

SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/987,064

Applicant(s)

KAWANO ET AL.

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/582,293.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 9 to 11 in Paper No. 5 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - I. In claim 11, line 6, it is not clear what "previously" refers to. For example, it is not clear what is previous to what.
  - II. In claim 10, lines 2 and 3, the meaning of the phrase, "has a sharp particle size distribution" is not clear. What is a "sharp particle size distribution"?

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 to 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinkerton et al. (Pinkerton, US Patent No. 5,395,459) taken in view of Japanese Patent Document No. 8-188803 (Japan '803, cited by the applicants in the IDS submitted November 13, 2001).

Pinkerton teaches producing Sm-Fe-N based alloy powder comprising, forming a melt of Sm and Fe, quenching the Sm-Fe melt to form a solidified body, comminuting the Sm-Fe body to form an alloy powder and nitriding the Sm-Fe alloy powder to form the Sm-Fe-N based alloy powder (column 1, line 45 to column 2, line 10).

Japan '803 teaches a method of making a rare earth-transition metal alloy powder having a particle diameter of 0.1 to 1 micron, including Sm-Fe, comprising neutralizing a mixed solution of a rare earth salt and a transition metal salt to precipitate the rare earth metal and the transition metal, heating the precipitated rare earth metal and transition metal to form a composite oxide and reducing the composite oxide in the presence of a metal reducing agent to form the rare earth-transition metal powder. Japan teaches that this process produces rare earth-transition metal alloy powders at a low cost without using any melting step (see the English language abstract). The Examiner considers Japan '803's heating step used to form the composite oxide to be equivalent to applicants' calcining step. In view of this, it is the Examiner's position that Japan '803's process of forming the rare earth-transition metal alloy is the same as recited in applicants' claims.

Pinkerton and the claims differ in that Pinkerton teaches forming the Sm-Fe alloy from a melt while the instant claims teach forming the Sm-Fe alloy by precipitation, calcination and reduction and diffusion.

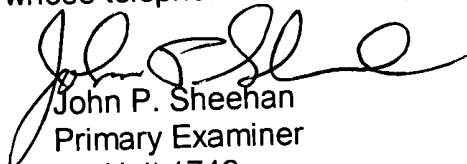
However one of ordinary skill in the art at the time the invention was made would have motivated to prepare the alloy used in Pinkerton's nitriding process by the process taught by Japan '803 so as to eliminate the melting step and produce the alloy used in Pinkerton's nitriding process more economically as taught by Japan '803.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps  
June 1, 2003